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Tami M. Procopio
Tami M. Procopio



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Daniel E. H. AFAR, *et al.*

Serial No.: 09/887,593

Filing Date: 21 June 2001

For: BPC-1: A SECRETED BRAIN-SPECIFIC PROTEIN EXPRESSED AND SECRETED BY PROSTATE AND BLADDER CANCER CELLS

Examiner: Gary B. Nickol, Ph.D.

Group Art Unit: 1642

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AMENDMENT UNDER 37 C.F.R. § 1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to an Office action herein mailed 25 March 2003, requiring a response by 25 April 2003. The response to a restriction requirement previously filed (mailed 23 December 2002) was objected to as non-responsive.

First, applicants apologize for failing to point out in their response that BPC-1 and 19P1E8 are synonyms. Page 39 of the specification, beginning at line 15 and continuing to line 36 explain that the gene initially called 19P1E8 was renamed BPC-1 (see lines 30-32). Thus, the claims are in fact directed to BPC-1, just by another name.

With respect to the further objection that the claims do not correspond to the elected group which is directed to inhibiting the processing of BPC in the cells of the cancer, the claims as submitted include this concept in a more generic way. Thus, the claims are consistent with the election. The claims as originally submitted simply did not include a claim directed to this genus which is directed to alter the status of the 19P1E8 (BPC-1) or the status of a molecule that is modulated by it. Included within this genus is the elected group. The status of 19P1E8 (BPC-1) would include its processing.

Accordingly, reconsideration of the holding that the previous response is not in compliance with any requirement is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. **511582001810**.

Respectfully submitted,

Dated: April 25, 2003

By: Kate H. Murashige
Kate H. Murashige
Registration No. 29,959

Morrison & Foerster LLP
3811 Valley Centre Drive, Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-5112
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| Docket No.: 511582800000 | Atty: Kate H. Murashige <i>NBT</i> |
| Serial No.: See Attached Appendix | Filing Date: See Attached Appendix |
| Title: N/A | |
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Papers enclosed herewith:

1. Transmittal Form (1 page)
2. Revocation of Prior Power of Attorney and Power of Attorney By Assignee (3 pages)
3. Appendix A (3 pages)
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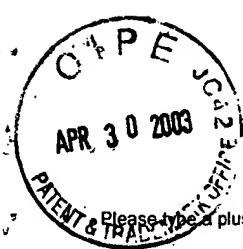
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| Filing Date | 21 June 2001 |
| First Named Inventor | Daniel E. H. AFAR, et al. |
| Group Art Unit | 1642 |
| Examiner Name | G. B. Nickol, Ph.D. |
| Attorney Docket No. | 511582001810 |

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| | |
|-------------------------|--|
| Firm or Individual Name | Kate H. Murashige Reg. No. 29,959 Morrison & Foerster LLP 3811 Valley Centre Drive, Suite 500, San Diego, California 92130 |
| Signature | |
| Date | April 25, 2003 |

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